

REMARKS

I. Introduction

Claims 15 and 17-28 are now pending in the present application after cancellation of claim 16. Claim 15 has been amended. Applicant hereby respectfully requests further examination and reconsideration of the application.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority, and the indication that all certified copies of the priority documents have been received.

II. Objection to Claim 16

Claim 16 has been canceled, thereby obviating Examiner's objection.

III. Rejection of Claims 15-19 and 23 under 35 U.S.C. § 102(b)

Claims 15-19 and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application No. EP 0 995 639 A2 ("Boran"). Claim 16 has been canceled. Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result

or characteristic.

Applicant notes that claim 15 has been amended to include the features of claim 16 (claim 16 is now canceled) and to clarify the subject matter recited therein. Amended claim 15 recites, in relevant parts, “wherein the piezo cable is configured such that the device detects a capacitance change by an impact object with the aid of the piezo cable, and wherein the capacitance change is used to characterize the relative dielectric constant of the impact object.”

In support of the rejection, the Examiner cites col. 6, l. 5-23 of Boran as teaching the following: “A capacitance change is detected by the control unit (40) with cable (46) as a result of the damage to the dielectricity (48) caused by an accident or by a change in the signal (82). As a result of the deformation of the shield (50), the capacitance of the capacitor (46, 48, 50) changes; col. 6 lines 5-23; fig. 3, 7).” However, the cited section of Boran has nothing to do with detecting a capacitance change by an impact object; instead, the cited section of Boran merely refers to “a diagnostic protection system” including a “diagnostic signal generation circuitry 70 [which] generates a signal 80 on the copper shield 50 with a predetermined voltage,” and “[a]ny absence of [the] output signal 82 indicates a connectivity failure somewhere in the sensing system.” In any case, it is clear that Boran has nothing to do with the additional claimed limitation that “the capacitance change [by an impact object] is used to characterize the relative dielectric constant of the impact object.”

For at least the foregoing reasons, claim 15 is allowable. Claims 17-19 and 23 ultimately depend from claim 15 and are therefore allowable for at least the same reasons.

IV. Rejection of Claims 20-22 and 25 under 35 U.S.C. § 103(a)

Claims 20-22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boran in view of U.S. Patent No. 6,534,999 B2 (“Brown”). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of

presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 20-22 and 25 ultimately depend from claim 15. As noted above, Boran fails to anticipate parent claim 15. In addition, the secondary Brown reference does not overcome — and is not asserted to overcome — the critical shortcomings of the primary Boran reference as applied against claim 15. Accordingly, the overall teachings of Boran and Brown fail to render obvious claims 20-22 and 25. Withdrawal of the obviousness rejection of claims 20-22 and 25 is respectfully requested.

V. Rejection of Claim 24 under 35 U.S.C. § 103(a)

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boran in view of UK Patent Application No. GB 2317707 A (“Bergner”). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

Claim 24 ultimately depends from claim 15. As noted above, Boran fails to anticipate

parent claim 15. In addition, the secondary Bergner reference does not overcome — and is not asserted to overcome — the critical shortcomings of the primary Boran reference as applied against claim 15. Accordingly, the overall teachings of Boran and Bergner fail to render obvious claim 24. Withdrawal of the obviousness rejection of claim 24 is respectfully requested.

VI. Rejection of Claims 26-28

Claims 26-28 were rejected as failing to distinguish over the disclosure of Boran. Applicant submits that the rejection should be withdrawn for at least the following reasons.

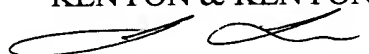
Claims 26-28 ultimately depend from claim 15. Therefore claims 26-28 are allowable for at least the same reasons as claim 15. In addition, to the extent the Examiner contends that claims 26-28 recite “product-by-process” limitations, this contention is clearly false: claim 26 specifies the location of the piezo cable, which has nothing to do with the process of making the piezo cable. To the extent claims 27 recites that the “piezo cable is injected into the trim,” and 28 recites that the “piezo cable is clamped into the trim,” injecting and clamping of the piezo cable have nothing to do with process of making the piezo cable; instead, these limitations merely specify the process for securing the piezo cable at the claimed location of “the trim.” Withdrawal of the rejection of claims 26-28 is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that pending claims 15 and 17-28 are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

 (P. NO. 36,197)

Dated: 9/5, 2008

By: JONG LEE for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
One Broadway
New York, NY 10004
(212) 425-7200